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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,541	08/28/2003	Daniel C. Birkestrand	ROC920030176US1	9041
46797 7590 02/19/2008 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829				
EXAMINER LANIER, BENJAMINE				
ART UNIT 2132		PAPER NUMBER		
MAIL DATE 02/19/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/650,541

**Applicant(s)**

BIRKESTRAND ET AL.

**Examiner**

BENJAMIN E. LANIER

**Art Unit**

2132

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment filed 21 December 2007 amends claims 28, 36, and 44.

Applicant's amendment has been full considered and entered.

***Response to Arguments***

2. Applicant's argument that Lewis does not disclose on-demand hardware resources has been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Circenis, U.S. Patent No. 7,146,496.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 28 recites the limitation "the compliance state" in line 13. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 28-51 are rejected under 35 U.S.C. 102(c) as being anticipated by Circenis, U.S. Patent No. 7,146,496. Referring to claims 28, 44, Circenis discloses a capacity on demand system wherein a user can purchase and is provided authorized access to computer system components (Col. 5, lines 23-60), which meets the limitation of recording a compliant state of the computerized apparatus, with respect to the on-demand resource, in which a system function uses the on-demand resource with authorization, wherein on-demand resource is a hardware component of the computerized apparatus. Inactive components that the user has not yet paid for can be temporarily accessed by the user (Col. 5, line 66 – Col. 6, line 3) for a predetermined period (Col. 6, lines 14-17), which meets the limitation of determining an in compliant state of the computerized apparatus, with respect to the on-demand resource, in which the system function uses the on-demand resource without authorization, and initiating a grace period during which the system function continues to use the on-demand resource while in the in compliant state, wherein the computerized apparatus transitions from the compliance state to the in compliant state and then initiates the grace period in a manner providing continuous availability of the on-demand resource to the system function.

Referring to claims 29, 45, Circenis discloses that the capacity on demand computer system is implemented as a partitionable computer system (Col. 8, lines 8-10), which meets the limitation of the system function is a partition manager.

Referring to claims 30, 46, Circenis discloses that the temporary access is for a predetermined period (Col. 6, lines 14-17), which meets the limitation of initiating the grace period comprises initiating a countdown counter.

Referring to claims 31, 47, Circenis discloses that once the period has expired access to the components is prohibited (Col. 8, line 64 - Col. 9, line 16), which meets the limitation of preventing the system function from using the on-demand resource after expiration of the grace period.

Referring to claims 32, 48, Circenis discloses that once a user has purchased additional capacity, the temporary access period is reset to reflect the purchased amount (Col. 9, lines 33-36), which meets the limitation of terminating the grace period if the system is returned to a compliant state.

Referring to claims 33-34, 49, 50, Circenis discloses that the state information is maintained within the computer system (Col. 7, lines 56-59), which meets the limitation of recording the compliant state comprises writing to a smart chip, determining the in compliant state comprises reading a smart chip.

Referring to claims 35, 51, Circenis discloses that the capacity on demand computer system comprises a processor, memory, and storage (Figure 2).

Referring to claim 36, Circenis discloses a capacity on demand management system wherein a user can purchase and is provided authorized access to computer system components (Col. 5, lines 23-60), which meets the limitation of on-demand resources configured to be claimed for use by a function, wherein on-demand resources comprise a hardware component, a capacity manager, which when executed by a processor, is configured to enable the on-demand resources for use by the function, wherein the computerized apparatus is in a compliant state when the function only claims usage of the enabled on-demand resources and does not claim any disabled on-demand resources. Inactive components that the user has not yet paid for can be

temporarily accessed by the user (Col. 5, line 66 – Col. 6, line 3) for a predetermined period (Col. 6, lines 14-17), which meets the limitation of initiate a grace period during which the function may continue to use the on-demand resource while in an in compliant state for a defined period of time, wherein the computerized apparatus is in the in compliant state when the function claims usage of the disabled on-demand resources, and wherein the grace period is initiated in response to the computerized apparatus transitioning from the compliant state to the in compliant state, thereby providing continuous availability of the on-demand resources to the function.

Referring to claim 37, Circenis discloses that once the period has expired access to the components is prohibited (Col. 8, line 64 - Col. 9, line 16), which meets the limitation of the capacity manager is further configured to implement an enforcement policy restricting the use of the on-demand resources after expiration of the grace period.

Referring to claim 38, Circenis discloses that the capacity on demand computer system is implemented as a partitionable computer system (Col. 8, lines 8-10), which meets the limitation of the function is a partition manager for managing a plurality of logical partitions.

Referring to claim 39, Circenis discloses that the state information is maintained within the computer system (Col. 7, lines 56-59), which meets the limitation of a persistent storage device to store state information used to determine whether the computerized apparatus is in the compliant state or the in compliant state with respect to the function's claim to usage of the on-demand resources.

Referring to claim 40, Circenis discloses that the capacity on demand computer system comprises a processor, memory, and storage (Figure 2).

Referring to claims 41-43, Circenis discloses that access to the components is allowed once a user has paid for access and has provided a codeword (Col. 7, lines 60-67), which meets the limitation of the capacity manager is configured to enable the on-demand resources by unlocking the on-demand resources and making the on-demand resources available for use upon request, configured to receive enablement codes configured to enable the on-demand resources, configured to determine whether each enablement code is valid by determining whether the enablement code is unique to the computerized apparatus.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Slater, U.S. Publication No. 2004/0010544

Circenis, U.S. Publication No. 2004/0148394

Camble, U.S. Publication No. 2003/0135580

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/  
Primary Examiner, Art Unit 2132